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Alex Krister Raith

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COATS & BENNETT, PLLC
1400 Crescent Green, Suite 300
Cary, NC 27518

EXAMINER

RYMAN, DANIEL J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/807,975	Applicant(s) RAITH ET AL.	
	Examiner DANIEL J. RYMAN	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 29 January 2008 have been fully considered but they are not persuasive. In the Response, Applicant initially asserts that "[t]he rejection of claims 1-14 and claims 26-30 as being indefinite under 35 U.S.C. § 112, second paragraph, is improper." Page 13. Specifically, Applicant asserts that "Applicant's use of the word 'default' in the rejected claims plainly is not inconsistent with" the definition of "default" given in the Merriam-Webster Dictionary, namely "'a selection made usually automatically or without active consideration due to lack of a viable alternative,' or 'a selection automatically used by a computer program in the absence of a choice made by the user'". *Id.* Examiner respectfully disagrees that the claims are not inconsistent with these definitions.

2. Examiner notes that both of Applicant's definitions share one common feature – performing the default selection due to an absence of an alternative (in Applicant's first definition the selection is made "due to lack of a viable alternative"; in Applicant's second definition the selection is made "in the absence of a choice made by the user"). In other words, a value is not a default value unless it is selected due to an absence of an alternative. This implies that in most selections there is a viable alternative to the default value that is selected – otherwise the term "default" would apply to every selected value, thus rendering the term "default" meaningless, i.e. if *every* selected value is a "default value" then the term "default" does not place further restrictions on the recited value, such that the term "default" is superfluous. In summary, for the claimed term "default format" to have any meaning, there must be an alternative to the "default format" that can be selected in most situations. For example, in the

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context of the claim, the term “default format” would be properly applied to a format that is selected when there is no format specified for the destination network address, where a format is specified for most destination network addresses. However, no such structure is ever presented in applicant’s claim.

3. Rather, claim 1 recites: “selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses.” Here, the claim only requires the selection of a default format as a function of a destination network address. There is no mention that another format could be selected, where the selection of the default format only occurs when the another format is not available. Thus, the claim requires that every selection of a format also be the selection of a “default format.” The use of the term “default” in this context renders the metes and bounds of the claim vague and indefinite.

4. It is presumed that every word in Applicant’s claim has meaning. However, as outlined earlier, if every selection in Applicant’s system is a “default selection,” as is currently required by the claims, then the use of the term “default” is superfluous. This creates an ambiguity – if the word “default” is superfluous, then why is it included in the claim? Alternatively, if the word “default” is not superfluous, then which formats are not “default formats”? In view of the foregoing, Examiner asserts that Applicant’s use the term “default” in the claims is inconsistent with the proffered dictionary definitions.

5. Applicant goes on to assert that “its use of the term ‘default’ in the rejected claims is abundantly clear to those skilled in the art, in view of the specification.” Response: p. 14.

Examiner respectfully disagrees. As outlined above, the use of the term “default” in the claims is

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inconsistent with the plain meaning of the term. While Examiner recognizes that Applicant can act as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Examiner cannot find any place in the Specification where Applicant has redefined the term “default” by setting forth a definition so as to put one reasonably skilled in the art on notice that Applicant has redefined the term. In view of the foregoing, Examiner asserts that Applicant’s use of the term “default” in the claims is inconsistent with how one of ordinary skill in the art would understand the term, even when the claim is read in light of the specification.

6. Applicant further asserts that Examiner’s decision not to examine claims 14 and 26-30 “is improper and by itself prevents the next action from being made final.” Examiner respectfully disagrees. Examiner notes that Applicant provides no statute or case which dictates that solely rejecting a claim under 35 U.S.C. § 112, second paragraph, is improper such that a subsequent action *has* to be non-final, and, to Examiner’s knowledge, no statute or case mandates this outcome. Examiner recognizes that section 2143.03 of the MPEP recites *Ex Parte Ionescu* as establishing that “[i]f a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.” (Citing to *Ex Parte Ionescu*, 222 USPQ 537, 539 (Bd. Pat. App. & Inter. 1984))

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However, the MPEP also instructs a person to compare *Ex Parte Ionescu* with *In re Wilson*, which establishes that “if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious,” and *In re Steele*, which establishes that “it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions.”

7. In line with the instruction from the MPEP, Examiner will proceed to compare these cases. In *Ex Parte Ionescu*, it appears that no prior art was of record at the time of appeal. 222 USPQ at 539 (“The examiner has not relied on any prior art”). In addition, the court stated that “[a] reasonable interpretation of claims 1 through 15 convinces us that those claims are not indefinite.” *Id.* at 540. As such, the Board held that when a claim is subject to two interpretations and one interpretation would render the claim unpatentable over the prior art, then the examiner should reject the claims under both the prior art and 35 U.S.C. 112, second paragraph. *Id.*

8. In *In re Wilson*, the Board of Appeals had simply ignored vague language in the claim and proceeded to find that the portions of the claim that were not ignored were obvious in view of the prior art of record. 165 USPQ 494, 496 (CCPA 1970). The U.S. Court of Customs and Patent Appeals held that indefinite language should not be ignored and “[i]f no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious – the claim becomes indefinite.” *Id.*

9. Similarly, in *In re Steele*, the examiner and the Board employed a variety of assumptions to arrive at a claim that could be rejected in view of the prior art. 134 USPQ 292, 295 (CCPA 1962). The U.S. Court of Customs and Patent Appeals stated, after noting that “considerable

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speculation as to meaning of terms employed and assumptions as to the scope of such claims were made by the examiner and the board,” *id.*, “[w]e do not think a rejection under 35 U.S.C. 103 should be based on such speculations and assumptions.” *Id.*

10. In summary, these cases stand for the following proposition: If a clear meaning of the claims can be readily ascertained, then the examiner should make a rejection under both 35 U.S.C. § 112, second paragraph, and either 35 U.S.C. 102 or 103 (*Ex Parte Ionescu*); however, if a claim is so poorly constructed that an interpretation would require Examiner to either ignore claim language (*In re Wilson*) or make assumptions as to the scope of the claims or speculate as to the meaning of terms (*In re Steele*), then the claims should only be rejected only under 35 U.S.C. 112, second paragraph. Thus, contrary to Applicant’s assumption, there are instances in which it is proper to only apply a rejection under 35 U.S.C. § 112, second paragraph, and Applicant’s claim creates one of these instances.

11. In the present case, there is “no one interpretation that would render the claim unpatentable over the prior art.” *In re Ionescu*, 222 USPQ at 539. As currently written, claim 14 requires: “determining whether default transcoding is desired based on the destination network address of that message, and if default transcoding is not desired, determining whether specified transcoding is desired based on determining whether a domain database indicates that specified transcoding is desired for the destination network address of that message.” In other words, if the “default transcoding” is not a viable alternative because it is not desired, then “specified transcoding” should be performed. According to Applicant’s previously asserted definition of “default,” i.e. “a selection made usually automatically or without active consideration due to a lack of a viable alternative,” Response: p. 13, the “specified transcoding” rather than the “default

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transcoding” should be labeled as the “default”. Thus, to make sense, the claim would have to be rewritten to require the currently claimed “specified transcoding” be the “default” and to have the currently claimed “default transcoding” not be a “default.” But if the default transcoding is not a default, then Examiner is forced to develop an appropriate definition for the “default transcoding”. To do so, Examiner is required to make assumptions as to the scope of the claim, which is clearly inappropriate under *In re Steele*. Therefore, since Examiner cannot interpret the claim without impermissibly making assumptions as to the scope of the claim, Examiner should not apply prior art to the claim.

12. Claim 26 requires: “selectively performing default transcoding of multimedia content in the message based on identifying the destination address as one for which default transcoding is indicated; selectively performing specified transcoding of multimedia content in the message based on identifying the destination address as one for which specified transcoding is indicated.” In other words, depending on the destination address of the message, the system determines whether to perform “default transcoding” or “specified transcoding,” i.e. the destination addresses of some messages specify that “default” transcoding should be performed and other addresses specify that “specified transcoding” should be performed. Applicant asserts that “default” should be defined as “a selection made usually automatically or without active consideration due to a lack of a viable alternative.” Response: p. 13. However, here there is no requirement that the “default transcoding” only be applied if the “specified transcoding” does not offer a viable alternative. Thus, to make sense, the claim would have to be rewritten to require the currently claimed “default transcoding” be applied only if the “specified transcoding” is not viable. This interpretation requires the Examiner to make assumptions as to the scope of the

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claim, i.e. that the default transcoding is applied only if the specified transcoding is not viable, which is clearly inappropriate under *In re Steele*. Therefore, since Examiner cannot interpret the claim without impermissibly making assumptions as to the scope of the claim, Examiner should not apply prior art to the claim.

13. In view of the foregoing, Examiner maintains that it was appropriate to reject the claims 14 and 26-30 only under 35 U.S.C. § 112, second paragraph.

14. Applicant goes on to assert that “the basis for [not examining claims 14 and 26-30] directly rests on the erroneous dictionary definition assigned by the Patent Office to the word ‘default’ as used in the claims at issue.” Response: p. 14. Applicant then asserts that “Claims 14 and 26-30 are readily examinable if only the Patent Office gives ‘default’ its unambiguous meaning as consistent with the specification and its normally understood meaning.” *Id.*

Examiner respectfully disagrees. As outlined above, Applicant’s proffered definitions fail to remedy the ambiguities of claims 14 and 26-30, such that using Applicant’s definitions would require Examiner to impermissibly make assumptions as to the scope of the claim. In view of the foregoing, Examiner maintains that it was appropriate to reject the claims 14 and 26-30 only under 35 U.S.C. § 112, second paragraph.

15. On page 15 of the Response, Applicant asserts that the claim rejections under 35 U.S.C. § 102(e) “fail and must be withdrawn, as the record established by the Patent Office explicitly demonstrates that the examiner used an improper definition of the term ‘default’ as used in the rejected claims.” Examiner respectfully disagrees. Examiner maintains that the definitions proffered by Applicant create ambiguities within the claims, such that Examiner is required to interpret the claim in a manner that renders the prior art applicable. *Ex Parte Ionescu*, 222

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USPQ at 539. *See also* MPEP § 2143.03. If Applicant does not agree with the definition that Examiner used for the term “default” then Applicant is free to clearly define the term in the claims – provided that this definition results in the “claims particularly pointing out and distinctly claiming the subject matter which the application regards as his invention,” as required by 35 U.S.C. § 112, second paragraph.

16. Applicant then discusses various teachings in the Specification which Applicant asserts “exemplifies” the meaning of “default” and “specific.” Applicant is reminded that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Here, Applicant has failed to *explicitly* define the terms “default” and “specific” in the Specification. As such, it is inappropriate for Examiner to read in Applicant’s “exemplifications” from the Specification to define the terms in the Specification. Further, Examiner maintains that, even if Examiner could read in these limitations from the Specification, the claims would continue to be vague and indefinite under 35 USC § 112, second paragraph, such that Examiner would be required to interpret the claims to apply the prior art, because, as outlined above, Applicant’s asserted definitions set up ambiguities in the claims.

17. Finally, Applicant asserts that Trossen does not disclose the use of the claimed default format. Response: p. 16. Examiner maintains that Trossen anticipates the claims in light of the definition given to “default” by Examiner. In view of the foregoing, Examiner maintains that the claims are vague and indefinite, such that Examiner is required to interpret the claim in a manner that renders the prior art applicable. *Ex Parte Ionescu*, 222 USPQ at 539. *See also* MPEP §

2143.03. If Applicant does not agree with the definition that Examiner used for the term “default” then Applicant should amend the claims to resolve these ambiguities.

18. In view of the foregoing, Examiner maintains that the rejection of the claims is proper.

Claim Rejections - 35 USC § 112

19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20. Claims 1-14 and 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

21. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “default” in claims 1 and 26 is used by the claim to mean “a particular format specified for a particular destination address”, while the accepted meaning is “in the absence of,” Webster’s Collegiate Dictionary. Thus, the term “default” would be applied consistent with its accepted meaning if the default format was applied to a destination address when no other format was designated. Since the claims appear to require that the “default format” be specified for certain destination addresses, the term “default” is indefinite because the specification does not clearly redefine the term. For purposes of prior art rejections, Examiner will treat the “default format” to be any format specified by a destination address. Examiner notes that this interpretation does

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not work in claims 14 and 26 since it would require a determination of the transcoding to be performed, and then require an additional determination of the transcoding to be performed, where this transcoding would have been determined in the previous determination step.

Therefore, Examiner will not make any prior art rejection for claims 14 and 26-30.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

23. Claims 1-4, 9-13, 15, 16, 18-20, 22-23, 25, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Trossen et al. (US 2004/0111476).

24. Regarding claims 1 and 31, Trossen discloses a method of and apparatus for processing multimedia messages outgoing from an originating network, the method comprising the steps of and the apparatus comprising means for: selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses (¶ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information); and sending the messages according to their destination network addresses (¶ [0029], where the message is sent to a user).

25. Regarding claim 2, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their

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destination network addresses comprises performing transcoding for messages targeted to email addresses (¶ [0002], where MMS allows the use of email, and ¶ [0036], where “addressing information” is generically specified, such that it includes email addresses, see also ¶¶ [0065]-[0067], where an exemplary rules database performs certain functions based on email addresses).

26. Regarding claim 3, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises not performing transcoding for messages not targeted to email addresses (¶ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information, such that users can specify not to perform transcoding on messages not targeted to email addresses).

27. Regarding claim 4, Trossen discloses selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses (¶ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information).

28. Regarding claim 9, Trossen discloses that the originating network comprises a first wireless communication network (Fig. 2 and ¶¶ [0025]-[0027], where the originating network is wireless communication network, ref. 212), and wherein sending the messages according to their destination network addresses comprises sending the messages from one or more Multimedia Messaging Services (MMS) servers in the first wireless communication network (Fig. 2 and ¶¶ [0025]-[0027], where the messages are send from MMS, ref. 214, in the originating network).

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29. Regarding claim 10, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses comprises performing default transcoding for outgoing messages targeted to Internet domains and not performing default transcoding for outgoing messages targeted to wireless network domains (¶ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information, such that the rules can be set in a manner in which “default transcoding” is performed for messages destined to IP domains and no “default transcoding” is performed for messages destined for wireless networks, see also ¶¶ [0046]-[0047]).

30. Regarding claim 11, Trossen discloses for outgoing messages targeted to wireless network domains, determining whether transcoding is desired for a particular outgoing message targeted to a particular wireless network domain, and, if so, transcoding at least a portion of the multimedia content in that message into a format specified for that particular wireless network domain (¶ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information, see also ¶¶ [0046]-[0047]).

31. Regarding claim 12, Trossen discloses that determining whether transcoding is desired for a particular outgoing message targeted to a particular wireless network domain comprises determining whether a database identifies that particular network as one for which transcoding is desired (¶¶ [0046]-[0047], where a network rule is checked to see if transcoding is required for a particular network, see also ¶¶ [0034],[0036]).

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32. Regarding claim 13, Trossen discloses identifying from information stored in the database the format specified for that particular network (¶¶ [0046]-[0047], where a network rule is checked to see if transcoding is required for a particular network, see also ¶¶ [0034],[0036]).

33. Regarding claims 15 and 32, Trossen discloses a method of and apparatus for processing multimedia messages outgoing from an originating network, the method comprising the steps of and the apparatus comprising means for: sending destination address information for an outgoing multimedia message from a first entity to a second entity (¶ [0023], where the user databases, i.e. a second entity, store the rules, and ¶ [0036], where the rules are stored according to address, such that to obtain a rule the processing element (the MMS server or rule processor as taught in ¶ [0024]), i.e. the first entity, would have to retrieve the rule from the user database, see also ¶ [0060], where the rule processor determines “whether any stored recipient rules are associated with the recipient of the [message]”); receiving at the first entity a corresponding indication from the second entity as to whether multimedia content transcoding is desired for the message (¶ [0023], where the processing element, i.e. the first entity, will receive the rule from the user database, i.e. the second entity, and ¶ [0034], where the rules deal with transcoding, see also ¶ [0060]); selectively performing transcoding at the first entity based on the indication (¶ [0060], where the rule processor performs the transcoding, see also ¶ [0034]); and sending the message from the first entity for delivery to the destination address (¶ [0029], where the message is sent to a user, and ¶ [0024], where the rules may be executed by the MMS server, which is also the device that transmits the message to the user).

34. Regarding claim 16, Trossen discloses that the second entity is external to the originating network (Fig. 2, where the originating network is ref. 212 and the database is stored in ref. 220, i.e. the database storing the rules is in the destination network, see also ¶ [0059]).

35. Regarding claim 18, Trossen discloses that the originating network comprises a first wireless communication network (Fig. 2 and ¶¶ [0025]-[0027], where the originating network is wireless communication network, ref. 212), and wherein sending destination address information for an outgoing multimedia message from a first entity to a second entity comprises sending an indication of a destination mobile telephone number targeted by the message (¶ [0036], where the rules are stored according to destination address, such as a telephone number).

36. Regarding claim 19, Trossen discloses receiving from the first entity a corresponding indication from the second entity as to whether multimedia content transcoding is desired for the message comprises receiving an indication from the second entity that identifies a desired format for transcoding at least a portion of the multimedia content in the message (¶ [0034], where it is implicit that the rule stores the desired format for the transcoding).

37. Regarding claim 20, Trossen discloses that selectively performing transcoding at the first entity based on the indication comprises determining whether the corresponding indication returned by the second entity indicates that transcoding is desired and, if so, transcoding at least a portion of the multimedia content in the message into the desired format (¶ [0034], where the message is transcoded if the rule dictates that transcoding is desired).

38. Regarding claims 22 and 33, Trossen discloses a method of and apparatus for processing multimedia messages outgoing from an originating network, the method comprising the steps of and the apparatus comprising means for: forwarding an outgoing multimedia message from a

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first entity to a second entity (¶ [0059], where the MMS server, i.e. the first entity, passes a received message to a rule processor, i.e. a second entity); receiving the message back from the second entity at the first entity, after the second entity has subjected the message to selective transcoding of multimedia content in the message (¶ [0059], where the MMS server, i.e. the first entity, receives the message back from the rule processor, i.e. a second entity, after the rule processor has executed rules, and ¶ [0061], where the rules include transcoding, see also ¶¶ [0034],[0036]); and sending the message from the first entity for delivery to the destination address (¶ [0059], where the MMS server, i.e. the first entity, delivers the message content).

39. Regarding claim 23, Trossen discloses that the second entity is external to the originating network (Fig. 2, where the originating network is ref. 212 and the database is stored in ref. 220, i.e. the database storing the rules is in the destination network, see also ¶ [0059]).

40. Regarding claim 25, Trossen discloses that the second entity selectively performs transcoding of multimedia content in the message by determining whether transcoding is desired for the message based on a destination address of the message and, if transcoding is desired, transcoding at least a portion of multimedia content in the message from a first coding format into a second coding format (¶ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and ¶ [0036], where the recipient rules can be associated with the respective recipients based on addressing information).

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

42. Claims 5-8, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trossen et al. (US 2004/0111476).

43. Regarding claim 5, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses comprises determining that an outgoing message is targeted to a particular address, and transcoding at least a portion of the multimedia content in the message into a format specified for the targeted address (§ [0034], where “one or more recipient rules can be defined such that the media content is transcoded”, and § [0036], where the recipient rules can be associated with the respective recipients based on addressing information).

Trossen does not expressly disclose that the particular address is related to a particular wireless network domain. However, Trossen does disclose specifying a particular type of message be delivered over a particular type of network (§ [0046], where a rule can be defined that requires media content to be delivered over a given type of network, and where the networks are wireless networks), where the type of network may require a specific format for delivery (§ [0047], where the network may require transcoding). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine that an outgoing message is targeted to a particular wireless network domain and transcoding at least a portion of the content in the message into a format specified for the targeted wireless network domain to ensure that the message is delivered over a given network in a format appropriate for that network.

44. Regarding claim 6, Trossen discloses that determining that an outgoing message is targeted to a wireless network domain comprises identifying a targeted mobile telephone number

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for the outgoing message (§ [0036], where addresses can be telephone numbers) and identifying a name of the wireless network domain based on accessing an ENUM database that associates mobile station telephone numbers with particular wireless network domains (§ [0046], where the rules database, i.e. an ENUM database, implicitly associates the telephone number with particular domains, e.g. 2G mobile networks or 3G mobile networks, since the type of network is identifies based on the incoming message, which includes destination telephone number).

45. Regarding claim 7, Trossen discloses that selectively transcoding multimedia content in outgoing multimedia messages from a current format into one or more specified formats as a function of their destination network addresses comprises transcoding audio content in the outgoing message from a first audio coding format associated with the originating communication network into a second audio coding format specified for the targeted wireless network domain (§§ [0046]-[0047], where a rule can be defined that requires media content to be transcoded before delivery over a given type of network).

46. Regarding claim 8, Trossen does not expressly disclose that the originating network comprises either a GSM wireless communication network, or a cdma2000 wireless communication network, and the targeted wireless network domain corresponds either to a GSM wireless communication network, or to a cdma2000 wireless communication network. However, Trossen does disclose that the originating network is a 2G mobile network or a 3G mobile network and that the destination network is a 2G mobile network or a 3G mobile network (§ [0046]). Examiner takes official notice that GSM is a well-known 2G wireless communication protocol and that cdma2000 is a well known 3G wireless communication protocol. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have

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the originating network comprise either a GSM wireless communication network, or a cdma2000 wireless communication network, and the targeted wireless network domain corresponds either to a GSM wireless communication network, or to a cdma2000 wireless communication network to increase the industrial applicability of Trossen's system by allowing it to operate over commonly used wireless communication protocols.

47. Regarding claim 17, Trossen does not expressly disclose that sending destination address information for an outgoing multimedia message from a first entity to a second entity comprises forwarding the message from the first entity to the second entity, and wherein the message includes the destination address information. However, Trossen does disclose sending the entire message to a second entity when the entity processes the message (¶ [0059]). Trossen also discloses that the rules may be retrieved according to any of a number of manners (¶ [0036]), such that rules may be retrieved based on more information than just the destination address information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to send to the second entity the entire message to allow the second entity to retrieve from the message the pertinent information needed to retrieve the pertinent rule.

48. Regarding claim 21, Trossen does not expressly disclose that sending the message from the first entity for delivery to the destination address comprises sending the message to a multimedia server in a destination network for subsequent delivery to a targeted recipient. However, Trossen does disclose that a first MMS server in an originating network will send the message to a second MMS server in a destination network (¶¶ [0056]-[0059]). Trossen also discloses that the rules may be used to provide more efficient communication over a network (¶ [0045]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of

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the invention to send the message to a multimedia server in a destination network for subsequent delivery to a targeted recipient to enable the message to be delivered in a manner in which efficient communication can be utilized over the network connecting the originating and destination multimedia servers.

Conclusion

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sevanto et al. (USPN 6,848,008), see entire document which pertains to selective transcoding.

50. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL J. RYMAN whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 8:00am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel J. Ryman
Primary Examiner
Art Unit 2616

/Daniel J. Ryman/
Primary Examiner, Art Unit 2616